

REMARKS/ARGUMENTS

Favorable consideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-3, 5-12, 14-19, 21-26, and 28-30 are pending in the application, with Claims 4, 13, 20 and 27 cancelled, Claim 30 added, and Claims 1, 7, 8, 10, 16, 17, 23, and 24 amended by the present amendment.

In the outstanding Office Action, Claim 7 was rejected under 35 U.S.C. § 112, first paragraph, Claims 1, 4, 8, 10, 13, 16, 17, 20, 23, 24 and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Togashi (U.S. Patent No. 6,824,131); Claims 1, 4, 8, 10, 13, 16, 17, 20, 23, 24 and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Togashi II (U.S. Patent Publication No. 2002/0036377); Claims 1, 4, 8, 10, 13, 16, 17, 20, 23, 24 and 27 were rejected under 35 U.S.C. § 102(f) as being anticipated by Togashi; Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Togashi II in view of Billings et al. (U.S. Patent No. 6,688,590); Claims 3, 12, 19 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Togashi II in view of Japanese Publication No. 2002-68511; Claims 2, 5, 11, 14, 18, 21, 25 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Togashi II in view of Shimazu et al. (U.S. Patent No. 5,997,965); and Claims 6, 15, 22 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Togashi II in view of Takehara et al. (U.S. Patent No. 5,802,434).

Applicants acknowledge with appreciation the personal interview between the Examiner, the Examiner's supervisor and Applicants' representative on June 16, 2005. During the interview, the Examiners acknowledged that amending the claims to remove a recitation of 'metal' would overcome the rejections under 35 U.S.C. 102. The Examiners also acknowledged that the stripping finger of Shimazu and the separation pawl of Takehara

do not perform the same function as Applicants' claimed tilt member, and thus that the rejections under 35 U.S.C. 103(a) based on these references is improper.

Claim 7 is amended to correct a typographical error, thus overcoming the rejection 35 U.S.C. § 112, first paragraph. Claims 1, 7, 8, 10, 16, 17, 23, and 24 are amended to delete any reference to 'metal.' Support for these amendments is found in Applicants' originally filed specification. Claim 7 is amended and Claim 30 added to recite additional features disclosed in Applicants' originally filed specification.¹ No new matter is added.

Briefly recapitulating, amended Claims 1, 7, 8, 10, 16, 17, 23, and 24 recite, inter alia, a tilt face and a contact face each comprising one of a) polybutylene terephthalate (PBT), b) polyethylene (PE), c) poly-ether-ether-ketone (PEEK), and d) polyimide (PI). With Applicants' claimed devices, paper jams are reduced.²

Togashi and Togashi II describe a tilt face 6a comprising either resin or metal.³ The tilt face may be covered with an elastic metal plate 9.⁴ However, as acknowledged by the Official Action, Togashi and Togashi II each fail to disclose or suggest a tilt face 6a and a contact face each comprising one of a) polybutylene terephthalate (PBT), b) polyethylene (PE), c) poly-ether-ether-ketone (PEEK), and d) polyimide (PI).

In view of the amendment of Claims 1, 7, 8, 10, 16, 17, 23, and 24 and the cancellation of Claims 4, 13, 20 and 27, Applicants submit the rejections under 35 U.S.C. § 102(e) and 102(g) are moot. That is, MPEP § 2131 notes that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed

¹ Specification, paragraph [0038].

² Specification, paragraph [0004] and Figure 5.

³ Togashi, column 9, line 65 – column 10, line 1; column 10, lines 40-56.

⁴ Togashi, column 10, lines 40-56.

anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in “at least one of two-digit, three-digit, or four-digit” representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02. “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because Togashi and Togashi II do not disclose or suggest all the features recited in independent Claims 1, 7, 8, 10, 16, 17, 23, and 24, Togashi and Togashi II do not anticipate the invention recited in independent Claims 1, 7, 8, 10, 16, 17, 23, and 24, and all claims depending therefrom.

As acknowledged during the interview of June 16, 2005, the stripping finger of Shimazu and the separation pawl of Takehara are not tilt members and do not perform the same function as Applicants’ claimed tilt member. That is, the stripping finger of Shimazu and the separation pawl of Takehara operate to remove a page from a drum, whereas Applicants’ tilt member operates to feed a page to a drum, and thus is subject to different stresses and wear. Thus, as discussed during the interview, the rejections under 35 U.S.C. 103(a) based on these references is improper.

JP 2002-68511 describes a separation pad made of polyethylene mixed into rubber. Applicants submit that the separation pad of JP 2002-68511 is neither a contact face of a tilt member nor a tilt face of a tilt member. Furthermore, Applicants’ claimed material is polyethylene, not polyethylene mixed with rubber.

MPEP §706.02(j) notes that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without addressing the first two prongs of the test of obviousness, Applicants submit that the Official Action does not present a *prima facie* case of obviousness because both JP 2002-68511, Shimazu and Takehara each fail to disclose all the features of Applicants' claimed invention.

Furthermore, Applicants submit there is no teaching, suggestion, or motivation, either explicitly or implicitly, in either reference to replace the metal or resin contact face with the components of JP 2002-68511, Shimazu and Takehara to arrive at Applicants' inventions recited in Claims 1, 7, 8, 10, 16, 17, 23, and 24 or in Applicants' original dependent claims. Thus, Applicants submit it is only through an impermissible hindsight reconstruction of Applicants' invention that the rejection of Claims 1, 7, 8, 10, 16, 17, 23, and 24 or Applicants' dependent claims can be understood.⁵

As described in Applicants' specification and summarized in Applicants' Figure 5, the present inventors conducted extensive testing to characterize various materials to be used as a contact face or tilt face. None of the cited references describe any testing or similar discussion of the pros and cons of various materials in a contact face or tilt face. In effect, the outstanding rejection does little more than attempt to show that parts of the inventive combination of Claim 1 were individually known in other arts and to suggest that such a showing is all that is necessary to establish a valid case of *prima facie* obviousness. The PTO

⁵ MPEP § 2143.01 "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge of one of ordinary skill in the art."

reviewing court recently reviewed such a rationale and dismissed it in *In re Rouffet*, 149 F. 3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) as follows:

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonic, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. [emphasis added.]

There has been no such showing of those required reasons made in the rejection.

For the Examiner's convenience, a machine translation of JP 2002-68511 is attached herewith (Attachment A). ✓

Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request and early and favorable action to that effect.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599
Michael Monaco
Registration No. 52,041

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

GJM:MM\la

I:\atty\mm\AMENDMENT\0557\236205\236205us-am DUE 5.21.05.doc